


Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

|  |  |   |                            |
|--|--|---|----------------------------|
| <b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>   |  | Docket Number (Optional)<br>2360-0528PUS1       |                            |
|  |  | Application Number<br>09/623,268-Conf.<br>#1826 | Filed<br>August 30, 2000   |
|  |  | First Named Inventor<br>Frank FILSER et al.     |                            |
|  |  | Art Unit<br>1791                                | Examiner<br>J. L. Lazorcik |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).<br/>Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest.<br/>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record.<br/>Registration number 29,271</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.<br/>Registration number if acting under 37 CFR 1.34. _____</p> <p style="text-align: right;"><br/>_____<br/>Signature<br/>Charles Gorenstein<br/>_____<br/>Typed or printed name<br/><br/>(703) 205-8000<br/>_____<br/>Telephone number<br/>October 19, 2009<br/>_____<br/>Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p> |  |   |                            |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

---

In re Patent Application of:  
Frank FILSER et al.

Application No.: 09/623,268

Confirmation No.: 1826

Filed: August 30, 2000

Art Unit: 1791

For: DENTAL CROWNS AND/OR DENTAL  
BRIDGES

---

Examiner: J. L. Lazorcik

**REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**INTRODUCTORY COMMENTS**

In response to the Final Office Action mailed May 18, 2009, Appellants respectfully request a pre-appeal brief conference, as Appellants request withdrawal of the rejections of record as being clearly factually and legally erroneous for the reasons set forth below. This request is being filed concurrently with a Notice of Appeal.

Claims 16-34 and 41-46 are pending, and these claims stand rejected as follows.

1) The first ground of rejection to be reviewed is the rejection of claims 16-34, 41-43 and 45 under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Wohlwend** (U.S. Patent No. 6,106,747) in view of Appellants' previous Exhibit A of a John **Halloran** letter dated April 6, 2004 (Final Office Action, paragraphs 1-2 at pages 3-9; hereinafter "Rejection (1)").

2) The second rejection is that of claim 44 under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Wohlwend** in view of **Halloran** as applied to claim 1 above in further view of **Guiot** et al. (U.S. Patent No. 6,287,121) (Final Office Action, paragraph 3 at pages 9-11; hereinafter "Rejection (2)").

3) The third rejection is that of claim 46 under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Wohlwend** in view of **Halloran** as applied to claim 1 above in further view of **Glass et al.** (Conference Proceedings -1995) (Final Office Action, paragraph 4 at pages 11-13; hereinafter "Rejection (3)").

Appellants are requesting review of all three rejections. It is worth noting that the enlargement factor (f) is recited in each of independent claims 16, 32, 33, 44, 45 and 46.

Regarding Rejection (1), and generally, the Examiner combines Wohlwend and the Halloran letter by: citing the generic enlargement factors in Wohlwend; stating that the claimed enlargement factor (f) is an "obvious solution"; and that the ordinary skill in the art is shown in Halloran (Office Action, pages 3-6). Thus, the Examiner concludes that determining enlargement factors such as that claimed is merely a "routine operation" (Office Action, page 6).

The cited primary reference of Wohlwend teaches the use of purely empirical enlargement factors (see, e.g., col. 3, lines 40-43 of Wohlwend), wherein the enlargement factor is assumed to be constant (see Appellants' response of January 12, 2009, starting at page 13). Put differently, the cited primary reference teaches a generic, "one-size fits all" parameter for blanks. The deficiencies of Wohlwend are also mentioned at page 5 of the current Office Action.

The presently claimed invention is directed to a specific enlargement factor "(f)" ( $f = \sqrt[3]{\rho_S/\rho_R}$ ) that is derived for each individual blank in a scientific and reproducible manner by taking into account the relative densities of the blank before and after sintering. As stated in Appellants' specification, the enlargement factor (f) compensates precisely for the shrinkage that occurs during sintering (see, e.g., page 3, lines 8-22) and is solves problems in the art.

As admitted in the Office Action, the cited primary reference of Wohlwend fails to disclose the instantly claimed enlargement factor that may be calculated on the base of a measurable parameter of the blank as well as failing to disclose the relation between relative densities of the blank and the enlargement factor. Wohlwend also fails to disclose a linear relationship between the enlargement factor and the shrinkage of the blank upon sintering.

But in the Office Action at page 5, last paragraph, the Examiner compensates for the deficiencies of Wohlwend by explaining how the claimed enlargement factor details "appear on their face to merely state an obvious solution to the enlargement operation contemplated and

disclosed by Wohlwend.” Of course, as also accounting for deficiencies of Wohlwend, the Halloran letter is cited as a secondary reference (Office Action, page 6) as disclosing the ordinary level of skill in the art and allegedly known problems in the art.

However, as a matter of fact and law Appellants note that the Examiner has accounted for the claimed enlargement factor in error. As previously explained, a exact mass conservation during sintering has to be assumed and a blank with homogeneous density distribution has to be provided. Only under these two pre-conditions would the enlargement factor be independent of the position in the blank and isotropic in all directions. These relationships/factors have only been disclosed *in Appellants’ specification*, and Wohlwend and Halloran do not mention such factors. Even if Halloran was considered, there is no guidance for one ordinary skill in the art to achieve the present invention, and any reliance on Halloran is improper hindsight reconstruction. The Examiner has not accounted for such factual errors in the all three rejections. In fact, Appellants have explained why Wohlwend refers to purely empirical enlargement factors (e.g., the skilled artisan would assume a non-isotropic enlargement factor; empirical enlargement factors represent averaged values and are much less precise).

Citing the Halloran letter is improper, as it does not constitute “prior art” as explained in Appellants’ response of January 12, 2009 (see page 14). It is worth noting that the Halloran letter was created after reviewing the present application. Further, the Halloran letter is being misconstrued as it was only be provided to show that the skilled artisan is able make use of the claimed invention with the specified enlargement factor (f), wherein other enlargement factors are known (but the claimed enlargement factor (f) is not known). Stating what is known in the art is not stating that the present invention is obvious, nor is there any admission by Appellants that the claimed enlargement factor (f) could be derived given the disclosure in Wohlend and the state of the art (based on the ordinary skill in the art, which is why Halloran is being cited).

Halloran is being misconstrued for another reason. While Halloran refer to starting density in the field of ceramics, referring to the level of skill in the art does not mean there is a solution to the problem or that the present invention is being accomplished. As explained, the Examiner has not taken into account the specific variables in the art or how one of ordinary skill in the art would be guided to the present invention. No scientific model or mathematical relation

is provided in the Halloran letter. One of ordinary skill in the art cannot be aware of a problem in the art and then all of a sudden achieve the present invention. Even homogeneity of the blank is not even mentioned as being a factor in determining an enlargement factor. Appellants note that an invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem(s) it solves. *In re Wright*, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988); *In re Spinnoble*, 160 USPQ 237 (CCPA 1969).

Thus, how can something be “routine” (Office Action, page 6, last paragraph) when the art (or the Examiner) does not recognize, e.g., homogeneity of the blank as being a factor? The Halloran letter is being misconstrued as prior art, and this is a factual error as well as a legal error in all three rejections.

Also, combining known prior art elements is not sufficient to render the claimed invention obvious if the results would not have been predictable to one of ordinary skill in the art. *United States v. Adams*, 383 U.S. 39, 51-52, 148 USPQ 479, 483-84 (1966). Again, the results cannot be predictable if the instantly claimed enlargement factor (f) is not even known, Wohlwend does not disclose any linear relationship between its enlargement factor and shrinkage of the blank, and Halloran refers to the enlargement factor “as defined in the patent application” and is not prior art. Appellant again note that any reference to enlargement factors in Halloran has only to do with a purely empirical enlargement factor such as that described in Wohlwend, and is not an admission that the instantly claimed enlargement factor (f) is obvious.

Regarding the assertion that the references are being argued “individually” (Office Action, page 14), Appellants respectfully disagree. How else can a patent applicant point out the problems and deficiencies of a reference without discussing the disclosure of that reference? If anything, the references are being considered individually. Appellants were merely relying on the deficiencies of each reference because the references have been improperly combined (factually and legally) and Appellants are traversing that the references could be properly combined in the first place (e.g., Halloran is not prior art and cannot be properly combined with Wohlwend). Thus, Appellants respectfully request (re)consideration of their previous remarks, because it appears that Appellants’ remarks have not been considered in the context of satisfying all requirements for a *prima facie* case of obviousness.

For reasons of record and as stated above, Rejection (1) amounts to a clear error on the Examiner's part and withdrawal of Rejection (1) is respectfully requested. Legally and factually, there is no *prima facie* case of obvious.

Regarding Rejection (2) of claim 44, the further citation of Guiot does not make the combination of Wohlwend and Halloran any more proper as explained above. For instance, Halloran is not even prior art, and there is no admission by Appellants that the instantly claimed enlargement factor (f) could be derived given the disclosure in the cited references.

Regarding Rejection (3) of claim 46, the further citation of Glass does not make the combination of Wohlwend and Halloran any more proper as explained above.


Therefore, these rejections amount to clear errors on the Examiner's part and withdrawal of Rejections (1)-(3) is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez, Reg. No. 48,501, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: October 19, 2009

Respectfully submitted,

By   
Charles Gorenstein  
Registration No.: 29,271  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road, Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant